IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Girsih K. Muralidharan	§	Group Art Unit: 2143
Serial No.: 10/723,864	§	Examiner: Fearer, Mark D.
Filed: November 26, 2003	§	Confirmation No.: 9698
For: METHOD AND APPARATUS FOR DYNAMICALLY ADAPTING IMAGE UPDATES BASED ON NETWORK PERFORMANCE	§	Atty. Docket: 138256-1 SV/YOD/DOO GEMS:0249

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF TRANSMISSION OR MAILING
37 C.F.R. 1.8

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. §1.6(d), or is being transmitted via the Office electronic filing system in accordance with 37 C.F.R. §1.6(a)(4), or is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

January 3, 2008	/Patrick S. Yoder/
Date	Patrick S. Yoder

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In light of the following remarks, Appellant respectfully requests review of the final rejection in the above-referenced application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. In the Advisory Action mailed December 21, 2007, the Examiner rejected claims 1-23, 31-35, and 40-49, and refused to enter the amendments to claims 15 and 41 set forth in the Response to Final Office Action mailed December 3, 2007. Claims 1-23, 31-35, and 40-49 remain pending in the present application. Appellant respectfully requests reconsideration of the pending claims in view of the following remarks.

Legal Error in Rejections of Claims 1-23, 31-35, and 40-49

In the Final Office Action, the Examiner rejected claims 1-23, 31-35, and 40-49 under 35 U.S.C. § 103(a) as being obvious over various pieces of prior art. The Examiner rejected independent claims 1 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Huffman, U.S. Publication No. 2004/0005094 (hereinafter "the Huffman reference") in view of Machida, U.S. Patent No. 6,642,943, (hereinafter "the Machida reference") and in further view of Wood et al., U.S. Patent No. 5,851,186 (hereinafter "the Wood reference"). The Examiner rejected the remaining independent claims 15, 31, 40, and 41 under 35 U.S.C. § 103(a) as being unpatentable over Tokunaga et al., U.S. Patent No. 5,968,132 (hereinafter "the Tokunaga reference") in view of the Wood reference. Additionally, the Examiner rejected dependent claims 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over the Huffman reference, as modified by the Machida reference, in further view of the Wood reference, and in further view of Deaven et al., U.S. 2005/0111711 (hereinafter "the Deaven reference"). Appellant respectfully traverses these rejections.

Improper Finality

Appellant submitted in the Response to Final Office Action that the finality of the Office Action mailed October 3, 2007 was improper based on the use of prior art which is disqualified under § 103(c). In particular, the Examiner rejected claims 12 and 14 under 35 U.S.C. § 103, using the Deaven reference. Appellant respectfully submitted that the Deaven reference did not qualify as prior art against the application under 35 U.S.C. § 103(a), in accordance with 35 U.S.C. § 103(c) and Pub. L. 106-113, § 4807. The Examiner was reminded that subject matter which qualifies as prior art only under subsection (e) of 35 U.S.C. § 102, shall not preclude patentability on obviousness grounds where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. It was pointed out to the Examiner that at the time the present invention was made, the invention disclosed by the instant application and the invention disclosed in the Deaven reference were both owned by or under an obligation of assignment to GE Medical Systems Inc. Further, the reel and frame locations of 014752/0201, 016469/0189, and 014755/0552 showing the recorded Assignments were pointed out to the Examiner.

Appellant showed that the Deaven reference only qualified as prior art under 35 U.S.C. §102(e), and further that in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l)(3), the Deaven reference could not qualify as prior art that might be used in a maintaining the rejection.

The Examiner was reminded that without the Deaven reference, the Examiner's rejection of claims 12 and 14 under 35 U.S.C. § 103(a) could not stand. Further, it was noted that because none of the art of record available as prior art disclosed or suggested all of the elements recited in claims 12 and 14, the Examiner had issued an improper and untimely Final Office Action. As such, the Examiner was petitioned to withdraw the finality and either allow claims 12 and 14 or provide a new ground of rejection in a future *non-final* Office Action, in accordance with M.P.E.P. 706.07(a).

In an effort to expedite prosecution, Appellant inserted claim recitations from claim 12 into independent claim 15 and from claim 14 into independent claim 41 in the Response to Final Office Action. No other amendments were made. The amendments, as well as the petition to withdraw finality for the reasons listed above, were apparently ignored by the Examiner and the amendments were not entered. If the amendments are for any reason considered untimely, Appellant will withdraw them for later entry. In light of the arguments above, Appellant respectfully requests that the Advisory Action and the improper Final Office Action be withdrawn.

Omitted Features of Independent Claims 1 and 42

The Examiner failed to reject all recitations of independent claims 1 and 42. Independent claims 1 and 42 recite, *inter alia*, "*a scanner module* configured to modify a scanning rate of the image data; *and an encoder module* configured to modify an encoding format of the image data." (Emphasis added). The Examiner relied on the Huffman reference to disclose a scanner module and an encoder module, citing paragraphs 8, 20, and 48. Final Office Action, pages 15-16 and 21-22. However, these sections of the Huffman reference disclose only what may be considered an encoder module. The Huffman reference details compression of images, but it fails to disclose a *scanner module* configured to *modify a scanning rate* of image data *in addition to* an encoder, as recited in independent claims 1 and 42. At best Huffman describes generating a set of pixel coordinates to identify a portion of the source image at a specified resolution for

compression. *See* Huffman, paragraph 48, FIG. 4. However, generating pixels at a specified resolution of a single frame is more akin to *encoding* the format of the image data, and is not equivalent to modifying a scanning rate of the image data. Modifying a scanning rate of the image data, for example, includes capturing fewer frames per second. *See* Specification, paragraph 38. Conversely, modifying a scanning rate of the image data does not involve modifying the resolution of the captured frames as described in the Huffman reference. Therefore, the Huffman reference fails to teach a scanner module, as well as fails to teach both an encoder module *and* a scanner module, as recited in independent claims 1 and 42.

Moreover, it was shown that the remaining prior art references applied against independent claims 1 and 42 did not overcome the deficiencies of the Huffman reference with respect to independent claims 1 and 42. *See* Response to Final Office Action, page 13. Thus, the cited prior art, taken alone or in hypothetical combination, fails to disclose all elements of independent claims 1 and 42. Accordingly, the Examiner issued an improper and untimely Final Office Action. As such, Appellant respectfully requests withdrawal of the Section 103 rejection of independent claims 1 and 42, and further requests allowance of independent claims 1 and 42, as well as all claims depending therefrom.

Omitted Features of Independent Claim 15 and 41

Amended independent claim 15 recites, *inter alia*, "wherein the serving station utilizes a *remote framebuffer protocol* to transmit the modified image data to the served station." (Emphasis added). Amended independent claim 41 recites, *inter alia*, "wherein the serving station receives local input data from a local operator via an *input device that is coupled to the serving station*." (Emphasis added). The cited language of claim 15 and 41 parallel improperly rejected claims 12 and 14, respectively. The Deaven reference is the only piece of prior art used by the Examiner to teach a serving station that utilizes a remote framebuffer protocol to transmit modified image data to the served station and receives local input data from a local operator via an input device that is coupled to the serving station. However, as discussed above, the Deaven reference does not qualify as prior art that may be used in a rejection under 35 U.S.C. § 103(a). Therefore, the Deaven reference may not be used to overcome the deficiencies of the cited prior art with respect to independent claims 15 and 41. Accordingly, Appellant respectfully requests

withdrawal of the Section 103 rejection of independent claims 15 and 41, and further requests allowance of independent claims 15 and 41, as well as all claims depending therefrom.

Omitted Features of Independent Claims 31 and 40

Independent claims 31 and 40 recite, *inter alia*, "comparing the network performance *to a specified range*." (Emphasis added). The Examiner relied on the Tokunaga reference to disclose comparing the network performance to a specified range, citing column 22, lines 46-54. Final Office Action, pages 7 and 10. However, this section of the Tokunaga reference discloses only a comparison of current traffic to *an initial traffic value*. The Tokunaga reference does not describe comparing the network performance to *a specified range*.

Moreover, it was shown that the remaining prior art references applied against independent claims 31 and 40 did not overcome the deficiencies of the Tokunaga reference with respect to independent claims 31 and 40. *See* Response to Final Office Action, page 14. Thus, the cited prior art, taken alone or in hypothetical combination, fails to disclose all elements of independent claims 31 and 40. Accordingly, the Examiner issued an improper and untimely Final Office Action. As such, Appellant respectfully requests withdrawal of the Section 103 rejection of independent claims 1 and 42, and further requests allowance of independent claims 1 and 42, as well as all claims depending therefrom.

Conclusion

In view of the above remarks, Appellant respectfully requests that the Panel instruct the Examiner to withdraw the outstanding rejections under 35 U.S.C. §§ 103 and allow the pending claims.

Respectfully submitted,

Date: January 3, 2008

/Patrick S. Yoder/

Patrick S. Yoder
Reg. No. 37,479
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
138256-1SV/YOD (GEMS:0249)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on January 03, 2008

Signature /Patrick S. Yoder/

Typed or printed name Patrick S. Yoder

Application Number	Filed
10/723,864	11/26/2003

First Named Inventor: Girish K. Muralidharan

Art Unit	Examiner
2109	Fearer, Mark D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 37,479
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Patrick S. Yoder/
Signature

Patrick S. Yoder
Typed or printed name

(281) 970-4545
Telephone number

January 03, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [X] *Total of 1 forms are submitted.